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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


Applicant(s): MICHAEL L. DENBY)
Serial No.: 09/546,502) Ex: ROWAN
Filed: 11 APRIL 2000) Art Unit: 3643
For: FISHING LINE AND LURE)
 CONNECTORS)

CERTIFICATE OF MAILING

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that the attached Transmittal of Response to Notification of Non-Compliant Appeal Brief; New Brief and two copies of the same; New Supplemental Appeal Brief and two copies of the same and a postcard are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents P.O. Box 1450 Alexandria, VA 22313-1450, on 08 June 2006.


Signature

08 June 2006

4000 North Central
Suite 1220
Phoenix, Arizona 85012
(602) 252-7494

08 June 2006
Date

Respectfully Submitted,



Michael W. Goltry
Attorney for Applicant
Reg. No. 39,692
CN 45848



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: MICHAEL L. DENBY)
Serial No.: 09/546,502) Ex: ROWEN
Filed: 11 APRIL 2000) Art Unit: 3643
For: FISHING LINE AND LURE)
CONNECTORS)

TRANSMITTAL OF RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL
BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed is the New Supplemental Appeal Brief for Appellant and two copies of same; Appellant's Response to Notification of Non-Compliant Appeal Brief and two copies of the same, in compliance with the Rules, in the above captioned matter and postcard for return receipt.

Respectfully submitted,

Michael W. Goltry
Attorney for Applicant
Registration No. 39,692

08 June 2006

CUSTOMER NO. 45848
4000 North Central
Suite 1220
Phoenix, Arizona 85012

(602) 252-7494



PATENT
Serial Number: 09/546,502

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Michael L. Denby

Serial No.:
09/546,502

Filed:
11 April 2000

Ex: Rowen, Kurt C.
Art Unit: 3643

For:
FISHING LINE AND LURE
CONNECTORS

NEW SUPPLEMENTAL APPEAL BRIEF FOR APPELLANT
IN COMPLIANCE WITH 37 CFR 41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop APPEAL BRIEF-PATENTS

SIR:

This is responsive to the Notice of Non-Compliant Appeal Brief mailed **11 May 2006**. A period for response was set for 1 month, up to and including **11 June 2006**.

In response to Appellant's appeal brief filed June 11, 2003, the Examiner in this case reopened prosecution and submitted a non-final Office Action, which was mailed on August 27, 2003, in which a shortened statutory period for response was set for 3 months, to and including November 27, 2003. Rather than file a reply under 37 C.F.R. § 1.111, Appellant elected reinstatement of the appeal and the

consideration of a Supplemental Appeal Brief filed 27 January 2004.

Appellant incorporates herein by reference the New Brief for Appellant in Compliance with 37 CFR 41.37 filed herewith on June 8, 2006.

Applicant acknowledges that the rejections set forth in the 2 December 2002 Final Office Action have been withdrawn by the Examiner in view of the Appeal Brief filed 11 June 2003.

I. REAL PARTY IN INTEREST

All of the right, title and interest in and to the above-described Patent Application are owned by Appellant Michael L. Denby, who is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly

affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

1. Claims 1-36 were originally filed in this case, and claims 37-41 are new. Claims 4-36 are canceled. Claim 1 is amended. Claim 2 is original. Claims 3, 37, 38, 40, and 41 are amended. Claims 1-3 and 37-41 are pending in this case, and are being appealed.
2. A copy of claims 1-3, and 37-41, the claims on appeal, is provided in Claims Appendix A.
3. Claims 1-3 and 37 stand rejected under under 35 U.S.C. 103(a) as being unpatentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652).
4. Claims 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 4,864,767) in view of Drosdak (U.S. Patent 5,469,652).

IV. STATUS OF AMENDMENTS

No amendments were filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

The subject matter claimed in independent claim 1, on appeal, which is disclosed on pages 14-17 of appellant's specification in conjunction with FIGS. 1-4, is a apparatus for receiving and securing an end segment of a line. The apparatus consists of a body 30 including a receptacle 25 having inwardly directed extensions 35, an open first end 32 leading to receptacle 25 and an opposing second end 31. (lines 7-24, page 14 of the specification in conjunction with FIGS. 1-3. Receptacle 25 is capable of receiving therein and extensions 35 impinging thereagainst the end segment of a fishing line. (lines 5-6, page 15 of the specification in conjunction with FIG. 3A; line 24, page 15, to line 1, page 16, of the specification in conjunction with FIG. 3A). A pair of resilient hooks 40,41 is attached to the second end 31 of the body 30, which together constitute a coupler 26, are disposed in an overlapping state forming a continuous loop in which a lure is engagable thereto by forcing hooks 40,41 apart

and threading one of hooks 40,41 into and through a hook eye of the lure. (lines 1-20, page 17 of the specification in conjunction with FIGS. 2, 3, and 4).

Independent Claim 38

The subject matter claimed in independent claim 38, on appeal, which is disclosed on pages 14-18 of appellant's specification in conjunction with FIGS. 1-6, is a apparatus for receiving and securing an end segment of a line. The apparatus consists of a body 30 including a receptacle 25 having inwardly directed extensions 35, an open first end 32 leading to receptacle 25 and an opposing second end 31. (lines 7-24, page 14 of the specification in conjunction with FIGS. 1-3. Receptacle 25 is capable of receiving therein and extensions 35 impinging thereagainst the end segment of a fishing line. (lines 5-6, page 15 of the specification in conjunction with FIG. 3A; line 24, page 15, to line 1, page 16, of the specification in conjunction with FIG. 3A). A pair of opposed plates 48,49 is attached to the second end 31 of the body 30, which together constitute an embodiment of a coupler 47, and are biased together and carry prongs 50,51A,51B. (lines 5-18, page 18 of the specification in conjunction with FIGS. 5, 5A, and 6). Prongs 50,51A,51B are disposed between plates 48,49 and are capable of securing a

hook eye of a lure. (lines 12-18, page 18 of the specification in conjunction with FIGS. 5, 5A, and 6).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3 and 37 stand rejected under under 35 U.S.C. 103(a) as being unpatentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652). The first issue to be resolved in this appeal is, therefore, whether claims 1-3 and 37 are patentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652).

Claims 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 4,864,767) in view of Drosdak (U.S. Patent 5,469,652). The second issue to be resolved in this appeal is, therefore, whether claims 38-41 are patentable over Drosdak (U.S. Patent 4,864,767) in view of Drosdak (U.S. Patent 5,469,652).

VII. ARGUMENT

Issue #1: Whether claims 1-3 and 37 are patentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652)

Claims 1-3 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMahon (U.S. Patent 578,762) in view of Drosdak (U.S. Patent 5,469,652). Appellant respectfully traverses Examiner's rejections of claims 1-3 and 37. The claims are presented in one group by the examiner, that group of claims now on appeal being claims 1-3, and 37. None of the claims necessarily stands or falls together.

Independent Claim 1

In the August 27, 2003, Office Action (paper no. 19), Examiner asserts that the patents to Drosdak '652 and McMahon show fishing line and lure connectors; that Drosdak '652 shows a line connector having a body 7 having a receptacle or socket 9 having inwardly directed extensions 10; that Drosdak '652 shows the body is capable of receiving the end segment of fishing line 6; that Drosdak '652 shows a coupler 8; that Drosdak '652 shows a first open end leading to a receptacle and a second opposing end; that the patent to McMahon shows a connector having a body **a** and a coupler **b** attached to the body that is capable of engaging and supporting a fishing lure B, C; that the coupler is comprised of a pair of resilient hooks disposed in an overlapping state forming a continuous loop in which the lure part is engagable to the coupler by forcing the hooks

apart; and that in reference to claims 1-3, 37, it would have been obvious to provide McMahon with a coupler as shown by Drosdak '652 since merely one equivalent mechanical coupler is being substituted for another. Examiner also asserts that the hooks would be attached to the second end of the body and that Drosdak '652 shows the extensions positioned at spaced intervals along substantially the entire length of the receptacle and also shows the extensions being directed away from an open end of the body.

In Drosdak '652, coupler 8 is a threaded female socket. With respect to claims 1-3 and 37, Examiner states that it would have been obvious to provide McMahon with a coupler as shown by Drosdak '652 since merely one equivalent mechanical coupler is being substituted for another. Appellant respectfully submits that this obviousness rejection of claims 1-3 and 37 is confusing, overly conclusory, unsupported by the prior art, lacks specificity, and that the Examiner is using hindsight and the teachings of Appellant's disclosure to improperly reconstruct the invention set forth in claims 1-3 and 37.

The Examiner states that it would be obvious to provide McMahon with a coupler as shown by Drosdak '652 and supports this conclusion not on the teachings of the prior art but on

an overly broad and over-simplified conclusion that one equivalent mechanical coupler is being substituted for another. Although the Examiner states that McMahan has a coupler b, the Examiner states that it would be obvious to provide McMahan with a coupler as shown by Drosdak '652, which, based on the language of the Examiner's rejection and his construction of the prior art, indicates replacing McMahan's coupler b with a threaded female socket of Drosdak '652. This does not make Appellant's claimed invention. Assuming, *arguendo*, that the Examiner concluded that it would have been obvious to provide coupler b of McMahan with threaded socket 8 of Drosdak '652, this obviousness rejection also fails as there is nothing in McMahan or Drosdak '652 that provides this suggestion or motivation.

Although the Examiner has identified in the prior art a coupler b as in McMahan and a threaded socket as in Drosdak '652, Examiner has not identified a teaching or suggestion in McMahan and/or Drosdak '652 to combine these elements as claimed and set forth by Appellant in independent claim 1. In fact, because Drosdak '652 expressly teaches that connector 7 is expressly for providing a coupling between a leader and a fly line, and that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a

leader line, Drosdak '652 teaches away from McMahon, McMahon does not provide any motivation to combine the teachings of Drosdak '652, and there is no teaching or suggestion in McMahon and/or Drosdak '652 to make the invention claimed by Appellant in independent claim 1 other than what is provided in Appellant's specification. Accordingly, Appellant respectfully asserts that the Examiner erred rejecting claims 1-3 and 37 as obvious under 35 U.S.C. 103(a) as unpatentable over McMahon in view of Drosdak '652, that the combination of McMahon and Drosdak '652 is an improper combination, that the Examiner's section 103 rejection of claims 1-3 and 37 lack support in the prior art and also lack specificity, and that claims 1-3 and 37 are not obvious under section 103 as being unpatentable over McMahon in view of Drosdak '652.

The Examiner bears the burden of coming forward with evidence that supports the use of prior art references in combination. See C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998) (teaching, suggestion, or motivation to combine is an "essential evidentiary component of obviousness holding"); Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 957 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the

elements."); Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 959 (Fed. Cir. 1986) (Because virtually all inventions are combinations of old elements, the fact that invention at issue may be combination of known elements is irrelevant to the question of obviousness.). However, the Examiner has failed to establish sufficient information to support the requirement that the claimed invention would appear to have been obvious in view of the prior art, other than an overly conclusory, overly broad, unsupported, and over simplified statement that merely one equivalent mechanical coupler is being substituted for another.

The Examiner's rejection of claims 1-3 and 37 is not only overly broad and overly conclusory, it is also not at all specific as to how one of ordinary skill in the art would have found it obvious to practice Appellant's claimed apparatus within the scope of Appellant's claims as of the filing date of Appellant's application subject to appeal. The Examiner has failed to establish a prima facie case of obviousness with McMahan and Drosdak '652. In fact, the only possible source or suggestion to combine McMahon with Drosdak '652 comes from Appellant's patent application. The Examiner cannot use Appellant's patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. See ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732

F.2d 1572, 221 USPQ 929, 933 (Fed. Cir. 1984); In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (both the suggestion and reasonable expectation of success must be found in the prior art, and not in the applicant's disclosure). Furthermore, the mere fact that McMahon may be modified by Drosdak '652 in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification, which it does not. McMahon and Drosdak '652 fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner.

Rather than making an appropriate and well-reasoned obviousness rejection of claims 1-3 and 37, the Examiner is attempting to construct an elephant from mouse parts because while perhaps some of the elements of the Appellant's claimed invention may be individually present in McMahon and Drosdak '652, none of these references suggest combining those elements in the manner that the Appellant has combined them. The Examiner has not shown that any of the prior art references including McMahon and/or Drosdak '652, taken individually or together, suggest a motivation to combine the various elements as presently claimed by the Appellant.

Dependent claims 2, 3, 37

Claims 2, 3, 37 are each dependent upon a claim that is allowable according to the argument set forth above and, therefore, each of them is allowable.

Issue #2: Whether claims 38-41 are patentable over Drosdak (U.S. Patent 4,864,767) Drosdak (U.S. Patent 5,469,652).

Claims 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 4,864,767) Drosdak (U.S. Patent 5,469,652). Appellant respectfully traverses Examiner's rejections of claims 38-41. The claims are presented in one group by the examiner, that group of claims now on appeal being claims 38-41. None of the claims necessarily stands or falls together.

Independent Claim 38

In the August 27, 2003, Office Action (paper no. 19), Examiner asserts that the patents to Drosdak '767 and '652 show fishing line and lure couplers; that Drosdak '652, as discussed, shows a first open end leading to a receptacle and an opposing second end; and that Drosdak '767 shows a coupler attached to a body 10-12 in which the coupler comprises a pair of opposing plates 14, 14' which are biased together and

prongs 18, 20 carried by and between the plates capable of securing a hook eye of a lure. In reference to claim 38, Examiner asserts that it would have been obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652 since merely one mechanically equivalent coupler is being substituted for another and the function is the same.

In Drosdak '652, coupler 8 is a threaded female socket. With respect to claim 38, Examiner states that it would have been obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652 since merely one equivalent mechanical coupler is being substituted for another. Appellant respectfully submits that this obviousness rejection of claim 38 is confusing, overly conclusory, unsupported by the prior art, lacks specificity, and that the Examiner is using hindsight and the teachings of Appellant's disclosure to improperly reconstruct the invention set forth in claim 38.

The Examiner states that it would be obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652 and supports this conclusion not on the teachings of the prior art but on an overly broad and over-simplified conclusion that one equivalent mechanical coupler is being substituted for another. Although the Examiner states that Drosdak '767 has a coupler 14,14', the Examiner states that it would be

obvious to provide Drosdak '767 with a coupler as shown by Drosdak '652, which, based on the language of the Examiner's rejection and his construction of the prior art, indicates replacing McMahon's coupler 14,14' with a threaded female socket of Drosdak '652. This does not make Appellant's claimed invention. Assuming, *arguendo*, that the Examiner concluded that it would have been obvious to replace eyelet 12 of Drosdak '767 with threaded socket 8 of Drosdak '652, this obviousness rejection also fails as there is nothing in McMahon or Drosdak '652 that provides this suggestion or motivation.

Although the Examiner has identified in the prior art a coupler 14,14' as in Drosdak '767 and a threaded socket 8 as in Drosdak '652, Examiner has not identified a teaching or suggestion in Drosdak '767 and/or Drosdak '652 to combine these elements as claimed and set forth by Appellant in independent claim 1. In fact, because Drosdak '652 expressly teaches that connector 7 is expressly for providing a coupling between a leader and a fly line, and that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a leader line, Drosdak '652 teaches away from Drosdak '767, Drosdak '767 does not provide any motivation to combine the teachings of Drosdak '652, and

there is no teaching or suggestion in Drosdak '767 and/or Drosdak '652 to make the invention claimed by Appellant in independent claim 38 other than what is provided in Appellant's specification. Accordingly, Appellant respectfully asserts that the Examiner erred rejecting claims 38-41 as obvious under 35 U.S.C. 103(a) as unpatentable over Drosdak '767 in view of Drosdak '652, that the combination of Drosdak '767 and Drosdak '652 is an improper combination, that the Examiner's section 103 rejection of claims 38-41 lack support in the prior art and also lack specificity, and that claims 38-41 are not obvious under section 103 as being unpatentable over Drosdak '767 in view of Drosdak '652.

As previously stated, the Examiner bears the burden of coming forward with evidence that supports the use of prior art references in combination. See C.R. Bard, 157 F.3d at 1352; Arkie Lures 119 F.3d at 957; Custom Accessories, 807 F.2d at 959. However, the Examiner has failed to establish sufficient information to support the requirement that the claimed invention would appear to have been obvious in view of the prior art, other than an overly conclusory, overly broad, unsupported, and over simplified statement that merely one equivalent mechanical coupler is being substituted for another.

The Examiner's rejection of claims 38-41 is not only overly broad and overly conclusory, it is also not specific as to how one of ordinary skill in the art would have found it obvious to practice Appellant's claimed apparatus within the scope of Appellant's claims as of the filing date of Appellant's application subject to appeal. In this regard, the Examiner has failed to establish a prima facie case of obviousness with Drosdak '767 and Drosdak '652. In fact, the only possible source or suggestion to combine Drosdak '767 with Drosdak '652 comes from Appellant's patent application. As previously stated, the Examiner cannot use Appellant's patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention. See ACS Hosp., 221 USPQ at 933; In re Dow Chem. Co., 837 F.2d at 473. Furthermore, the mere fact that Drosdak '767 may be modified by Drosdak '652 in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification, which it does not. Drosdak '767 and Drosdak '652 fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner.

Rather than making an appropriate and well-reasoned obviousness rejection of claims 38-41, the Examiner, as with claims 1-3 and 37, is attempting to construct an elephant from

mouse parts because while perhaps some of the elements of the Appellant's claimed invention may be individually present in Drosdak '767 and Drosdak '652, none of these references suggest combining those elements in the manner that the Appellant has combined them. The Examiner has not shown that any of the prior art references including Drosdak '767 and/or Drosdak '652, taken individually or together, suggest a motivation to combine the various elements as presently claimed by the Appellant.

Dependent claims 39-41

Claims 39-41 are each dependent upon a claim that is allowable according to the argument set forth above and, therefore, each of them is allowable.

CONCLUSION

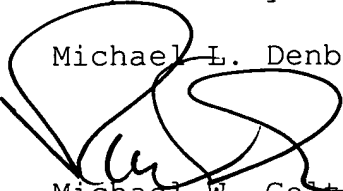
Appellant assert that following claims on appeal are not obvious and not unpatentable and should be allowed:

1. Independent claim 1 and dependent claims 2, 3, and 37; and
2. Independent claim 38 and dependent claims 39-41.

It is respectfully submitted that Appellants' claims 1-3 and 37-41 are clearly allowable and that this case is in condition for allowance. Appellant therefore prays for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

Michael L. Denby



Michael W. Goltry
Attorney for Appellant
Reg. No. 39,692

8 June 2006
PARSONS & GOLTRY
4000 North Central Avenue
Phoenix, Arizona 85012
Phone (602) 252-7494
Fax (602) 252-7198

CLAIMS APPENDIX A

1. Apparatus for receiving and securing an end segment of a line comprising:

a body including a receptacle having inwardly directed extensions, an open first end leading to the receptacle and an opposing second end;

the receptacle capable of receiving therein and the extensions impinging thereagainst the end segment; and

a pair of resilient hooks attached to the second end of the body and disposed in an overlapping state forming a continuous loop in which a lure is engagable to the coupler by forcing the hooks apart and threading one of the hooks into and through a hook eye of the lure.

2. Apparatus of claim 1, the receptacle having a length, wherein the extensions are positioned at spaced intervals along substantially the entire length of the receptacle.

3. Apparatus of claim 1, wherein the extensions are directed away from the open first end of the body leading to the receptacle.

37. Apparatus of claim 3, wherein the pair of resilient hooks extend away from the second end of the body opposing the open first end of the body.

38. Apparatus for receiving and securing an end segment of a line comprising:

a body including a receptacle having inwardly directed extensions, an open first end leading to the receptacle and an opposing second end;

the receptacle capable of receiving therein and the extensions impinging thereagainst the end segment; and

a pair of opposing plates attached to the second end of the body and biased together and prongs carried by and between the plates capable of securing a hook eye of a lure.

39. Apparatus of claim 38, the receptacle having a length, wherein the extensions are positioned at spaced intervals along substantially the entire length of the receptacle.

40. Apparatus of claim 38, wherein the extensions are directed away from the open first end of the body leading to the receptacle.

41. Apparatus of claim 40, wherein the pair of opposing plates extend away from the second end of the body opposing the open first end of the body.

EVIDENCE APPENDIX B

There is no evidence submitted pursuant to 37 C.F.R.
§§1.130, 1.131, or 1.132 or any other evidence entered and
relied upon in this appeal.

RELATED PROCEEDINGS APPENDIX C

There are no copies of decisions rendered by a court or the Board in any proceeding because there are no other appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.



PATENT
Serial Number: 09/546,502

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Michael L. Denby

Serial No.:
09/546,502

Filed:
11 April 2000

For:
FISHING LINE AND LURE
CONNECTORS

Ex: Rowen, Kurt C.
Art Unit: 3643

NEW BRIEF FOR APPELLANT IN COMPLIANCE WITH 37 CFR 41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Mail Stop APPEAL BRIEF-PATENTS

SIR:

This is responsive to the Notice of Non-Compliant Appeal Brief mailed 11 May 2006. A period for response was set for 1 month, up to and including 11 June 2006.

I. REAL PARTY IN INTEREST

All of the right, title and interest in and to the above-described Patent Application are owned by Appellant Michael L. Denby, who is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

1. Claims 1-36 were originally filed in this case, and claims 37-41 are new. Claims 4-36 are canceled. Claim 1 is amended. Claim 2 is original. Claims 3, 37, 38, 40, and 41 are amended. Claims 1-3 and 37-41 are pending in this case, and are being appealed.

2. A copy of claims 1-3, and 37-41, the claims on appeal, is provided in Claims Appendix A.
3. Claims 1-3 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of McMahon (U.S. Patent 578,762).
4. Claims 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of Drosdak (U.S. Patent 4,864,767).

IV. STATUS OF AMENDMENTS

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V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 1

The subject matter claimed in independent claim 1, on appeal, which is disclosed on pages 14-17 of appellant's specification in conjunction with FIGS. 1-4, is a apparatus

for receiving and securing an end segment of a line. The apparatus consists of a body 30 including a receptacle 25 having inwardly directed extensions 35, an open first end 32 leading to receptacle 25 and an opposing second end 31.

(lines 7-24, page 14 of the specification in conjunction with FIGS. 1-3. Receptacle 25 is capable of receiving therein and extensions 35 impinging thereagainst the end segment of a fishing line. (lines 5-6, page 15 of the specification in conjunction with FIG. 3A; line 24, page 15, to line 1, page 16, of the specification in conjunction with FIG. 3A). A pair of resilient hooks 40,41 is attached to the second end 31 of the body 30, which together constitute a coupler 26, are disposed in an overlapping state forming a continuous loop in which a lure is engagable thereto by forcing hooks 40,41 apart and threading one of hooks 40,41 into and through a hook eye of the lure. (lines 1-20, page 17 of the specification in conjunction with FIGS. 2, 3, and 4).

Independent Claim 38

The subject matter claimed in independent claim 38, on appeal, which is disclosed on pages 14-18 of appellant's specification in conjunction with FIGS. 1-6, is a apparatus for receiving and securing an end segment of a line. The apparatus consists of a body 30 including a receptacle 25 having inwardly directed extensions 35, an open first end 32

leading to receptacle 25 and an opposing second end 31.
(lines 7-24, page 14 of the specification in conjunction with FIGS. 1-3. Receptacle 25 is capable of receiving therein and extensions 35 impinging thereagainst the end segment of a fishing line. (lines 5-6, page 15 of the specification in conjunction with FIG. 3A; line 24, page 15, to line 1, page 16, of the specification in conjunction with FIG. 3A). A pair of opposed plates 48,49 is attached to the second end 31 of the body 30, which together constitute an embodiment of a coupler 47, and are biased together and carry prongs 50,51A,51B. (lines 5-18, page 18 of the specification in conjunction with FIGS. 5, 5A, and 6). Prongs 50,51A,51B are disposed between plates 48,49 and are capable of securing a hook eye of a lure. (lines 12-18, page 18 of the specification in conjunction with FIGS. 5, 5A, and 6).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-3 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of McMahon (U.S. Patent 578,762). The first issue to be resolved in this appeal is, therefore, whether claims 1-3 and 37 are patentable over Drosdak (U.S. Patent 5,469,652) in view of McMahon (U.S. Patent 578,762).

Claims 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of Drosdak (U.S. Patent 4,864,767). The second issue to be resolved in this appeal is, therefore, whether claims 38-41 are patentable over Drosdak (U.S. Patent 5,469,652) in view of Drosdak (U.S. Patent 4,864,767).

VII. ARGUMENT

Issue #1: Whether claims 1-3 and 37 are patentable over Drosdak (U.S. Patent 5,469,652) in view of McMahon (U.S. Patent 578,762). Claims 38-41.

Claims 1-3 and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of McMahon (U.S. Patent 578,762). Appellant respectfully traverses this rejection. The claims are presented in one group by the examiner, that group of claims now on appeal being claims 1-3, and 37. None of the claims necessarily stands or falls together.

Independent Claim 1

In paper no. 14, Examiner asserts that the patents to Drosdak '652 and McMahon show fishing line and lure connectors; that Drosdak '652 shows a line connector having a body 7 having a receptacle or socket 9 having inwardly directed extensions 10; that Drosdak '652 shows the body is capable of receiving the end segment of fishing line 6; that Drosdak '652 shows a coupler 8; that Drosdak '652 shows a first open end leading to a receptacle and a second opposing end; that the patent to McMahon shows a connector having a body **a** and a coupler **h** attached to the body that is capable of engaging and supporting a fishing lure B, C; that the coupler is comprised of a pair of resilient hooks disposed in an overlapping state forming a continuous loop in which the lure part is engagable to the coupler by forcing the hooks apart; and that in reference to claims 1-3, 37, it would have been obvious to provide Drosdak '652 with a coupler as shown by McMahon since merely one equivalent mechanical coupler is being substituted for another. Examiner also asserts that the hooks would be attached to the second end of the body and that Drosdak '652 shows the extensions positioned at spaced intervals along substantially the entire length of the receptacle and also shows the extensions being directed away from an open end of the body.

In accordance with standard Patent Office practice, the Examiner has the burden of establishing a prima facie case of obviousness. (Manual of Patent Examining Procedure, M.P.E.P. 2142). Three basic criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or the references when combined) must teach or suggest all the claim limitations. According to the U.S. Court of Appeals for the Federal Circuit, "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look to see whether combined *teachings* render the claimed subject matter obvious."¹ Also, "[o]bviousness cannot be established by combining the teachings of the prior art to produced the claimed invention, absent some teaching, suggestion or incentive supporting the combination."²

¹*In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549-50 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964)).

² See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

An invention does not make itself obvious; that suggestion or teaching must come from the prior art. In Drosdak '652, coupler 8 is a threaded female socket. With respect to claims 1-3 and 37, Examiner states that it would have been obvious to provide Drosdak '652 with a coupler, e.g., Appellant's claimed hooks 40,41, as shown by McMahan as a substitute for coupler 8 since merely one equivalent mechanical coupler is being substituted for another. However, at column 3, lines 4-8, Drosdak '652 states that "[w]hile I have illustrated a preferred embodiment of a connector 7 (enlarged for clarity), other shapes and styles of connectors could be used so long as they have a female threaded socket to receive the threaded butt end portion 4 of the leader line 1 to be attached." Accordingly, Examiner's conclusion that it would have been obvious to provide Drosdak '652 with a coupler, e.g., Appellant's claimed hooks 40,41, as shown by McMahan as a substitute for coupler 8 since merely one equivalent mechanical coupler is being substituted for another is not supported by Drosdak '652. Drosdak '652 expressly teaches that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a leader line. In Drosdak '652, it is essential that connector 7 incorporate a female threaded socket to receive the threaded butt end portion of the leader line to be attached. This is

not the case in applicant's invention as claimed in independent claim 1 and there is no teaching in Drosdak '652 of the desirability of substituting any other coupler for threaded female socket 8.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."³ Although the Examiner has identified in the prior art a connector as in Drosdak '652 and hooks as in McMahon, Examiner has not identified a teaching or suggestion in Drosdak '652 and/or McMahon to combine these elements as claimed and set forth by applicants in independent claim 1. In fact, because Drosdak '652 expressly teaches that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a leader line, Drosdak '652 teaches away from McMahon. Accordingly, Appellant asserts that the Examiner erred rejecting claims 1-3 and 37 as obvious under 35 U.S.C. 103(a) as unpatentable over Drosdak '652 in view of McMahon, that the combination of Drosdak '652 and McMahon is an improper combination, and that claims 1-3 and 37 are not obvious under section 103 as being unpatentable over Drosdak '652 in view of McMahon.

Dependent claims 2, 3, and 37

Claims 2, 3, and 37 are each dependent upon a claim that is allowable according to the argument set forth above and, therefore, each of them is allowable.

Issue #2: Whether claims 38-41 are patentable over Drosdak (U.S. Patent 5,469,652) in view of Drosdak (U.S. Patent 4,864,767).

Claims 38-41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Drosdak (U.S. Patent 5,469,652) in view of Drosdak (U.S. Patent 4,864,767). Appellant respectfully traverses this rejection. The claims are presented in one group by the examiner, that group of claims now on appeal being claims 38-41. None of the claims necessarily stands or falls together.

Independent Claim 38

In paper no. 14, Examiner asserts that the patents to Drosdak show fishing line and lure couplers; that Drosdak '652, as discussed above, shows a first open end leading to a receptacle and an opposing second end; and that Drosdak '767

³ Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d 953, 43 USPQ 2d

shows a coupler attached to a body 10-12 in which the coupler comprises a pair of opposing plates 14, 14' which are biased together and prongs 18, 20 carried by and between the plates capable of securing a hook eye of a lure. In reference to claim 38, Examiner asserts that it would have been obvious to provide Drosdak '652 with a coupler as shown by Drosdak '767 since merely one mechanically equivalent coupler is being substituted for another and the function is the same.

An invention does not make itself obvious; that suggestion or teaching must come from the prior art. In Drosdak '652, coupler 8 is a threaded female socket. With respect to claim 38, Examiner states that it would have been obvious to provide Drosdak '652 with a coupler as shown by Drosdak '767 since merely one mechanically equivalent coupler is being substituted for another and the function is the same. However, at column 3, lines 4-8, Drosdak '652 states that "[w]hile I have illustrated a preferred embodiment of a connector 7 (enlarged for clarity), other shapes and styles of connectors could be used so long as they have a female threaded socket to receive the threaded butt end portion 4 of the leader line 1 to be attached." Accordingly, Examiner's conclusion that it would have been obvious to provide Drosdak '652 with a coupler as shown by Drosdak '767 since merely one

mechanically equivalent coupler is being substituted for another and the function is the same is not supported by Drosdak '652. Drosdak '652 expressly teaches that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g., coupler 8, to receive the threaded butt end portion of a leader line. In Drosdak '652, it is essential that connector 7 incorporate a female threaded socket to receive the threaded butt end portion of the leader line to be attached. This is not the case in applicant's invention as claimed and there is no teaching in Drosdak '652 of the desirability of substituting any other coupler for this arrangement.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."⁴ Although the Examiner has identified, in the prior art, a connector as in Drosdak '652 and jaws 14,14' as in Drosdak '767, Examiner has not identified a teaching or suggestion in Drosdak '652 and/or Drosdak '767 to combine these elements as claimed and set forth by applicants in independent claim 1. In fact, because Drosdak '652 expressly teaches that connector 7 can have various shapes and styles so long as it has a female threaded socket, e.g.,

⁴ *Id.*

coupler 8, to receive the threaded but end portion of a leader line, Drosdak '652 teaches away from Drosdak '767. Accordingly, Appellant asserts that the Examiner erred rejecting claims 38-41 as obvious under 35 U.S.C. 103(a) as unpatentable over Drosdak '652 in view of Drosdak '767, that the combination of Drosdak '652 and Drosdak '767 is an improper combination, and that claims 38-41 are not obvious under section 103 as being unpatentable over Drosdak '652 in view of Drosdak '767.

Dependent claims 39-41

Claims 39-41 are each dependent upon a claim that is allowable according to the argument set forth above and, therefore, each of them is allowable.

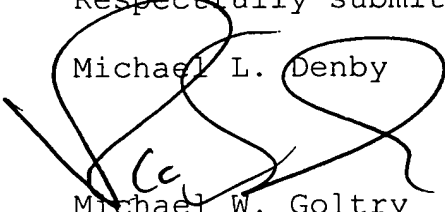
CONCLUSION


Appellant assert that following claims on appeal are not obvious and not unpatentable and should be allowed:

1. Independent claim 1 and dependent claims 2, 3, and 37; and
2. Independent claim 38 and dependent claims 39-41.

It is respectfully submitted that Appellants' claims 1-3 and 37-41 are clearly allowable and that this case is in condition for allowance. Appellant therefore prays for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,


Michael L. Denby


Michael W. Goltry
Attorney for Appellant
Reg. No. 39,692

8 June 2006
PARSONS & GOLTRY
4000 North Central Avenue
Suite 1220
Phoenix, Arizona 85012
Phone: (602) 252-7494
Fax: (602) 252-7198

CLAIMS APPENDIX A

1. Apparatus for receiving and securing an end segment of a line comprising:

a body including a receptacle having inwardly directed extensions, an open first end leading to the receptacle and an opposing second end;

the receptacle capable of receiving therein and the extensions impinging thereagainst the end segment; and

a pair of resilient hooks attached to the second end of the body and disposed in an overlapping state forming a continuous loop in which a lure is engagable to the coupler by forcing the hooks apart and threading one of the hooks into and through a hook eye of the lure.

2. Apparatus of claim 1, the receptacle having a length, wherein the extensions are positioned at spaced intervals along substantially the entire length of the receptacle.

3. Apparatus of claim 1, wherein the extensions are directed away from the open first end of the body leading to the receptacle.

37. Apparatus of claim 3, wherein the pair of resilient hooks extend away from the second end of the body opposing the open first end of the body.

38. Apparatus for receiving and securing an end segment of a line comprising:

a body including a receptacle having inwardly directed extensions, an open first end leading to the receptacle and an opposing second end;

the receptacle capable of receiving therein and the extensions impinging thereagainst the end segment; and

a pair of opposing plates attached to the second end of the body and biased together and prongs carried by and between the plates capable of securing a hook eye of a lure.

39. Apparatus of claim 38, the receptacle having a length, wherein the extensions are positioned at spaced intervals along substantially the entire length of the receptacle.

40. Apparatus of claim 38, wherein the extensions are directed away from the open first end of the body leading to the receptacle.

41. Apparatus of claim 40, wherein the pair of opposing plates extend away from the second end of the body opposing the open first end of the body.

EVIDENCE APPENDIX B

There is no evidence submitted pursuant to 37 C.F.R.
§§1.130, 1.131, or 1.132 or any other evidence entered and
relied upon in this appeal.

RELATED PROCEEDINGS APPENDIX C

There are no copies of decisions rendered by a court or the Board in any proceeding because there are no other appeals, interferences, or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.